

REMARKS

Claims 1-6, 14-15 and 21-27 are pending. Claims 7-13 and 16-20 were withdrawn, claim 1 was previously amended, claims 2-3, and 15 are original, and claims 4-6, 14, and 21-27 were previously presented.

In rejecting the claims under 35 U.S.C. 102 and under 35 U.S.C. 103, the Office Action concedes that each of the cited art, for example the W.L. Gore reference, does not expressly or impliedly teach the limitation relating to "introduction of the plurality of voids into the polymeric material effects a decrease in a bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material". Nonetheless, the Office rejects the claims, contending that this feature is inherently taught by the cited references. Applicant respectfully traverses this rejection at least because the Office has not met its burden to fully develop reasons supporting its reliance on the doctrine of inherency.

The Office always bears the initial burden to develop reasons supporting a reliance on inherency. (MPEP 2112 (IV)). To satisfy this burden, the Office must identify some basis in fact or articulate some reasoning at least tending to show that allegedly inherent subject matter necessarily (i.e., inevitability) flows from cited art. Indeed, the MPEP expressly instructs that:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Further, since a basis in fact and technical reasoning is required when inherency is invoked, a failure to provide such evidence or rationale is fatal to the reliance on this

doctrine. This is only logical since evidence "must make clear" that the allegedly inherent subject matter is necessarily present in (i.e., necessarily flows from) the disclosure of cited art. (*MPEP 2112*).

A review of the Office Action reveals the absence of the required rationale or evidence at least tending to show that this feature inevitably flows from the disclosure of W.L. Gore reference. The Office Action only states the following, "However, since the method of introducing voids (via conventional blowing agent) is identical to one of the methods disclosed in the specification of the instant application, it is reasonable believed that this step is inherently met by the disclosure of the W. L. Gore reference. It is further reasonable believed that the modulus of elasticity of a material is not affected by the presence of voids, thus the claimed limitation of introduction of the plurality of voids into the polymeric material effects a decrease in a bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material" is a mere re-statement of an inherent effect of introduction of voids into a material."

The Office Action finds inherency only based on "... it is reasonable believed that this step is inherently met ..." and "It is further reasonable believed that the modulus of elasticity of a material is not affected by the presence of voids ..." Thus, there is no extrinsic evidence that makes it clear that the subject matter necessarily (i.e., inevitably) flows from a disclosure of the W. L. Gore reference. It cannot reasonably be said that this is a reason supporting the Office's reliance on inherency. Consequently, the Office Action's reliance on inherency is unsupported and thus improper.

In sum, the Office Action concedes that the W.L. Gore reference does not teach the feature of the claims and any reliance on the doctrine of inherency to provide this necessary teaching is improper.

It is well settled that subject matter is inherent only when extrinsic evidence makes it clear that the subject matter necessarily (i.e., inevitably) flows from a disclosure of the cited art. (*MPEP 2112*). This requirement is a prerequisite to invoking the doctrine of inherency and cannot be avoided. Consequently, inherency may never be established by mere probabilities or even possibilities and the mere fact that a certain thing may be present (or may result) is always insufficient. (*MPEP 2112*).

The above reasoning for relying on the doctrine of inherency to provide necessary teaching is similarly improper with regard to the other cited references of Dement'ev, EP 660082 to Andrew AG, US 5,706,175 to Takei, WO99/36820 to SUN Microsystems Inc., US Patent 4,107,354 to Wilkenloch et al. The above arguments regarding inherency also apply to these references.

It is also stated in the Office Action, "However, should the applicants continue to present the arguments that the references do not inherently (not expressly) meet these limitations, the rejection under 112, first paragraph will be reinstated since, as discussed in the previous office actions, the invention as claimed is not enabled, as there is ABSOLUTELY no guidance which of the disclosed methods result on the products with the claimed properties." The previous response has addressed this issue and has referred to the numerous examples given in the specification. For example, on page 6 of the specification it is stated that the "polymeric material 204 comprises a solid material 206 and a plurality of voids 208". Pages 6 and 7 discuss the bulk modulus and Young's

modulus. Pages 7-10 describe 11 different procedures for providing voids in the solid material of the polymeric material.

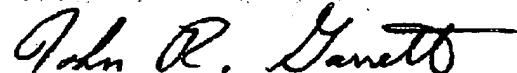
Thus, independent claim 1 is allowable over the cited art.

The dependent claims 2-6, 14, 15 and 21-27 include all the limitations of the respective independent claims upon which they depend and therefore are allowable over the cited prior art for the reasons set forth with regard to independent claims.

The Examiner is therefore respectfully requested to reconsider the rejection of the claims under 35 U.S.C. § 102(b) and 103(a).

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



John R. Garrett
Attorney for Applicant
Reg. No. 27,888

Dated: April 12, 2010

Carmen Patti Law Group, LLC
Customer Number 32205